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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/446,145 01/07/00 MIYAKE

H 0018-1086-PC

EXAMINER

HM22/0518

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PATEL, S

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

05/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/446,145

Applicant(s)

Hiroshi Miyake et al.

Examiner

Sudhaker Patel

Group Art Unit

1624

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-10 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

**Group I**, claim(s) 1-10, drawn to compounds, composition, and a method of use, and first process of making of compounds of Formula of claim 1 representing various substituents as Morpholine, Thiomorpholine, Pyrazine, Piperazine core classified in class 544 subclasses various depending on substituents R1, R2, R3, R4.

**Group II**, claim(s) 1-3,5,6,7-10, drawn to compounds, composition, and a method of use, and first process of making of Formula of claim 1 compounds representing various substituents as Pyridine, Piperidine core, classified in class 546 subclasses various depending on substituents R1, R2, R3, R4.

**Group III**, claim(s) 1-3,5,6,7-10, drawn to compounds, compositions, and a method of use, and first process of making of Formula of claim 1 compounds representing various substituents as Pyrrole, Thiazole, Imidazole, Indole core, classified in class 548 subclasses various depending on substituents R1, R2, R3, R4.

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**Group IV**, claim(s)1-10, drawn to Spiro/ Spirocyclo compounds.

**Group V**, claim 5, drawn to Intermediates and processes for Formulae Ib,Id,Ie,If.

**Group VI**, claim(s) 1-10, drawn to compounds not covered in **Groups I-V** above.

In addition to election of one of the above groups, applicants are also required to elect a single species from that group. If **Group VI** is elected, further restriction might be required.

2. The inventions listed as **Groups I-VI** do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: They represent different cores and use.

3. A telephone call was made to Mr. N.F.Oblon on Friday 5/12/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel whose telephone number is (703) 308 4709. The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308 4716.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

*Mukund J. Shah*

**Mukund Shah**

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**Supervisory Patent Examiner**

May 13, 2000

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